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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,183	10/05/2001	Akihiko Toyoshima	50P4257.05	3119

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ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,183

Applicant(s)

TOYOSHIMA, AKIHIKO

Examiner

Marcos L Torres

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 18-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 and 23-25, drawn to wireless module, classified in class 455, subclass 410.
 - II. Claims 18-22, drawn to activation server, classified in class 455, subclass 419.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as remote control and programming. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with John L. Rogitz on 3/10/04 a provisional election was made without traverse to prosecute the invention of wireless module, claims 1-17 and 23-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-22 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

1. Claims 24-25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 11-12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Helle.

As to claims 1-2 and 14, Helle discloses a method for providing security to a wireless module, said method comprising securing data to the wireless module and providing a security code to the wireless module after the wireless module has been activated (see col. 1, lines 9-35).

As to claims 11 and 12, Helle discloses notifying to the user of the peripheral device of said security code and requiring an input of the security code (see col. 3, lines 5-7).

As to claims 13 and 16, Helle discloses a security system for a wireless module comprising a wireless module configured to receive security data and a peripheral device in communication with said wireless module and configured to receive security data and transmit peripheral data (see col. 1, lines 9-35; col. 3, line 63 – col. 4, line 2; col. 1, lines 15-16).

4. Claims 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Findikli.

As to claims 23-24 and 25, Findikli discloses a wireless module comprising an electronic serial number, said wireless module configured to be in electronic communication with at least one peripheral device, said wireless module further configured to store said electronic serial number (see col. 4, lines 17-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helle in view of Borgelt.

As to claim 3, Helle discloses issuing a security code through wireless transmission to the wireless module (see col. 3, lines 46-55). Helle does not specifically disclose encrypting/decrypting security codes. Borgelt disclose encrypting/decrypting security codes (see col. 2, lines 23-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Helle method for the simple purpose of enhanced security.

As to claims 4-6 and 7, Helle discloses storing a security code in a wireless module (see col. 3, line 63 – col. 4, line 2) and peripheral device (see col. 1, lines 15-16).

8. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Helle in view of Borgelt as applied to claims 3-7 above, and further in view of Findikli.

As to claim 8 and 15, Helle discloses everything claimed as explained above except for providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device. Findikli discloses providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device (see col. 4, lines 17-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for security and tracking purposes.

As to claims 9 and 10, Helle discloses providing to a peripheral device data and storing said data to the wireless module (see col. 3, line 63 - col. 4 line 2).

As to claim 17, Helle discloses storing in peripheral device security code (see col. 1, lines 9-35). Helle does not specifically disclose providing to the wireless module with an electronic serial number. Findikli discloses providing to the wireless module with an electronic serial number and storing said electronic serial number to said peripheral device (see col. 4, lines 17-25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for security and tracking purposes.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Malek U.S. Patent US005243653A
- b. Leickel U.S. Patent US006696919B1
- c. Rosenberg U.S. Patent US006628934B2
- d. McGregor U.S. Patent US006424827B1
- e. Chan U.S. Patent US006128389A

Any response to this Office Action should be mailed to:

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Or faxed to:

(703) 703-872-9314

For formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2683


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Mlt